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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,409	03/09/2004	E. Carter Corriston JR.	9634/I	9031
27614 7590 09/12/2008 MCCARTER & ENGLISH, LLP FOUR GATEWAY CENTER 100 MULBERRY STREET NEWARK, NJ 07102				
EXAMINER				
LASTRA, DANIEL				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
09/12/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/796,409

Applicant(s)

CORRISTON ET AL.

Examiner

DANIEL LASTRA

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. Claims 1-13 have been examined. Application 10/796,409 (METHOD OF ADVERTISING AT RESIDENTIAL LOCATIONS) has a filing date 03/09/2004.

Response to Amendment

2. In response to Non Final Rejection filed 12/11/2007, the Applicant filed an Amendment on 06/11/2008, which amended claims 1, 3, 7, 10 and added new claims 12 and 13.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen (US 5,072,833) in view of Times Sq. Tryout for Wastebaskets with Ads (Dialog file: 471:04361731).

Claim 1, Hansen teaches:

A method of advertising at a residential location comprising:

providing a container having advertising indicia to a resident (see col 7, lines 15-30);

allowing the resident to use the container to dispose of waste or recycling near a curb (see col 8, lines 15-23); and

displaying the advertising indicia when the container is placed near the curb (see col 8, lines 15-23).

Hansen does not expressly teach *continuing to display the advertising indicia after the container has been emptied and subsequently re-using the container*. However, Times Sq. Tryout teaches that it is old and well known in the promotion art to have waste baskets with advertising on sides (see paragraph 1). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Hansen's advertisements would be placed on sides of waste baskets containers, where said advertisements would continue to be displayed after the containers have been emptied, as Time Sq. Tryout teaches that it is old and well known in the promotion art to have waste baskets with advertising on sides.

Claim 2, Hansen teaches:

wherein the step of providing the container comprises providing the container to the resident at no cost to the resident (see col 7, lines 40-55).

Claim 3, Hansen teaches:

A method of advertising at a residential location comprising:

determining whether waste or recycling is brought curbside at the location (see col 8, lines 15-25);

producing containers having advertising indicia thereon (see col 7, lines 17-35);

providing the containers to residents of the location (see col 7, lines 40-55);

and allowing the residents to use the containers to dispose of waste or recycling, the advertising indicia being displayed when the containers are positioned curbside (see col 8, lines 15-25).

Hansen does not expressly teach identifying a location where advertising is desirable. However, Official Notice is taken that it is old and well known in the promotion art to target advertisements based upon geographic location. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the commercial entities that sponsor the Hansen's recyclable material collection program would pay to target their ads based upon geographic location as it is old and well known to do so and also in view that Hansen distributes recycle bags targeted specifically to a particular community or consumer (see col 7, lines 5-60) where advertisers or sponsors (*i.e.* commercial entities) of said recyclable material collection program pay to place advertisements in said recycle bags (see col 7, lines 15-30).

Hansen does not expressly teach *continuing to display the advertising indicia after the container has been emptied and subsequently re-using the container*. However, Times Sq. Tryout teaches that it is old and well known in the promotion art to have waste baskets with advertising on sides (see paragraph 1). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Hansen's advertisements would be placed on sides of waste baskets containers, where said advertisements would continue to be displayed after the containers have been emptied, as Time Sq. Tryout teaches that it is old and well known in the promotion art to have waste baskets with advertising on sides.

Claim 4, Hansen teaches:

wherein the step of providing the containers comprises providing the containers to the residents at no cost to the residents (see col 7, lines 40-50).

Claim 5, Hansen teaches:

providing containers having advertising indicia thereon to residents of additional locations (see col 7, lines 15-30).

Claim 6, Hansen teaches:

wherein the step of producing the container comprises producing containers having advertising indicia relating to a business (see col 7, lines 20-30; "advertising or sponsorship materials can relate to those entities (e.g. municipal, commercial or otherwise) which either fund or participate in a particular recyclable material collection program").

Claim 7, Hansen teaches:

A method of advertising for businesses at residential locations comprising:

determining whether waste or recycling is brought curbside at the location (see col 8, lines 15-25);

identifying at least one business interested in advertising services in the location (see col 7, lines 20-30);

producing containers having advertising indicia relating to the business (see col 7, lines 20-30);

selling the containers to a business (see col 7, lines 20-30 "commercial fund or sponsor the recycle bags"; col 7, lines 45-50; "recycle bags can be offered for sale by retail outlets)

allowing the business to provide the containers to residents of the location (see col 7, lines 45-50); and

allowing the residents to use the containers to dispose of waste or recycling, the advertising indicia being displayed when the containers are positioned curbside (see col 7, lines 15-30; col 8, lines 15-25).

Hansen does not expressly teach identifying a location where advertising is desirable. However, Official Notice is taken that it is old and well known in the promotion art to target advertisements based upon geographic location. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the commercial entities that sponsor the Hansen's recyclable material collection program would pay to target their ads based upon geographic location as it is old and well known to do so and also in view that Hansen distributes recycle bags targeted specifically to a particular community or consumer (see col 7, lines 5-60) where advertisers or sponsors (*i.e.* commercial entities) of said recyclable material collection program pay to place advertisements in said recycle bags (see col 7, lines 15-30).

Hansen does not expressly teach *continuing to display the advertising indicia after the container has been emptied and subsequently re-using the container*. However, Times Sq. Tryout teaches that it is old and well known in the promotion art to have waste baskets with advertising on sides (see paragraph 1). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Hansen's advertisements would be placed on sides of waste

baskets containers, where said advertisements would continue to be displayed after the containers have been emptied, as Time Sq. Tryout teaches that it is old and well known in the promotion art to have waste baskets with advertising on sides.

Claim 8, Hansen teaches:

wherein the step of allowing the business to provide the containers comprises allowing the business to provide the containers to the residents of the location at no cost to the residents (see col 7, lines 40-50).

Claim 9, Hansen teaches:

determining additional locations where advertising is desirable (see col 6, lines 45-50 "bags distributed based upon a particular community");

determining additional businesses interested in advertising in the locations (see col 7, lines 15-25 "advertising material can relate to those entities (e.g. commercial) which either fund or participate in a particular recyclable material collection program");

providing containers to the additional businesses having advertising indicia relating to the additional businesses (see col 7, lines 20-30);

allowing the businesses to provide the containers to residents of the additional locations (see col 7, lines 20-30; "commercials fund the recyclable program by paying to place advertisements in different communities");

and allowing the residents to use the containers to dispose of waste or recycling, the advertising indicia being displayed when the containers are brought curbside for collection (see col 8, lines 15-25).

Claim 10, Hansen teaches:

A method of advertising for businesses at residential locations comprising:
performing a service at a resident's location;

determining whether waste or recycling is brought curbside at the location (see col 8, lines 15-25);

providing a container having advertising indicia relating to the services performed at the location (see col 7, lines 15-30);

and

allowing the resident to use the container to dispose of waste or recycling, the advertising indicia being displayed when the container is positioned curbside (see col 8, lines 15-25).

Hansen does not expressly teach *continuing to display the advertising indicia after the container has been emptied and subsequently re-using the container*. However, Times Sq. Tryout teaches that it is old and well known in the promotion art to have waste baskets with advertising on sides (see paragraph 1). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Hansen's advertisements would be placed on sides of waste baskets containers, where said advertisements would continue to be displayed after the containers have been emptied, as Time Sq. Tryout teaches that it is old and well known in the promotion art to have waste baskets with advertising on sides.

Claim 11, Hansen teaches:

wherein the step of providing the container comprises provide a container having advertising indicia relating to the business to the resident at no cost to the resident (see col 7, lines 20-30).

4. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen (US 5,072,833) in view of Times Sq. Tryout for Wastebaskets with Ads (Dialog file: 471:04361731) and further in view Pusateri (US 6,379,764).

Claim 12, Hansen teaches:

A method of advertising at a residential location comprising:

allowing the resident to apply the sticker to a container (see col 6, lines 35-45);

displaying advertising indicia when the container is placed near the curb (see col 7, lines 15-35);

Hansen does not expressly teach:

providing a sticker having advertising indicia to a resident;

continuing to display the advertising indicia after the container has been emptied and subsequently re-using the container. However, Times Sq. Tryout teaches that it is old and well known in the promotion art to have waste baskets with advertising on sides (see paragraph 1) and Pusateri teaches that it is old and well known in the promotion art that to further some of the goals of advertising, including name retention and promotion of product sales, advertising signature have been provided with repositionable labels that contain information such as name and telephone number of the advertiser or a coupon for a price discount, where the labels are repositionable so that they can be removed from the advertising signature and adhered at another location (for example a

desk or refrigerator) to remind a user to call the advertiser or to use the coupon at a later date (see col 1, lines 15-40). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Hansen would adhere advertisements in the form of adhere labels to the side of waste basket containers, where said advertisements would continue to be displayed after the containers have been emptied, as Time Sq. Tryout teaches that it is old and well known in the promotion art to have waste baskets with advertising on sides and Pusareti teaches that it is old and well known in the promotion art that to further some of the goals of advertising, including name retention and promotion of product sales, to have advertisers attached advertisements labels to the side of different objects in order to remind people viewing said advertisements to call the advertiser or to use a promotion at a later date.

Claim 13, Hansen teaches:

wherein the sticker is provided at no cost to the resident (col 7, lines 20-30).

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

/DANIEL LASTRA/
Examiner, Art Unit 3688

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September 10, 2008